

*REMARKS/ARGUMENTS**Applicants' Election*

Applicants elect, with traverse, the claims of Group I (claims 1-16) directed to a method of producing pluripotent stem cells comprising culturing testis cells in a medium comprising GDNF or an equivalent thereto to obtain pluripotent stem cells, for further prosecution. Reconsideration of the restriction requirement is hereby requested.

Discussion of the Restriction Requirement

The subject application is a U.S. national stage application based on the International Patent Application No. PCT/JP2004/017125. The Office alleges that the inventions defined by the claims of Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.2 because they lack the same "special technical feature." Under PCT Rule 13.2, a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. PCT Rule 13.2 defines the term "special technical feature" as meaning the technical feature that defines the contribution which each claimed invention, considered as a whole, makes over the prior art (see M.P.E.P. § 1893.03(d))

The claims of Groups I-IX are linked so as to form a single general inventive concept. In other words, the claims of Groups I-IX share at least one common special technical feature, which defines the contribution that each claim makes over the prior art. In this respect, the claims of Groups I-IX all recite the special technical feature of culturing test cells in a medium containing GDNF or an equivalent thereto to obtain pluripotent stem cells. Although the Office cites to Nagano et al. (*Biology of Reproduction*, 68: 2207-2214 (2003)) as evidence that the special technical feature is known in the art, Nagano et al. only discloses a method of expanding spermatogonial stem cells and does *not* disclose the production of pluripotent stem cells, as required by the pending claims. Spermatogonial stem cells and pluripotent stem cells derived from testis cells differ substantially in their properties (see, e.g., page 25, lines 22-32, and page 28, line 31, through page 32, line 9, of the specification).

Given the special technical feature common to the claims of Groups I-IX, the restriction requirement as between these groups of claims is not proper. In addition, a search

for prior art with respect to any of Groups I-IX would likely uncover references that would be considered by the Examiner during the examination of the other groups. As a result, the Examiner would incur no undue burden in examining the claims of Groups I-IX at the same time. See also M.P.E.P. § 803 ("If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions." (emphasis added)).

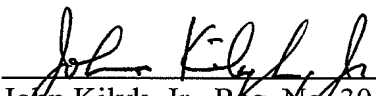
Indeed, Applicants note that the claims of Groups I and III-VIII should be examined together because the claims of each group are directed to methods that comprise the step of culturing testis cells using a medium containing GDNF or an equivalent thereto to obtain pluripotent stem cells (i.e., the special technical feature described above). Furthermore, the claims of Groups I, II and IX should be examined together because the claims of each group are related as a product (the claims of Group II), a process specially adapted for the manufacture of the product (the claims of Group I), and an apparatus or means specifically designed for carrying out the process (the claims of Group IX).

In view of the foregoing, Applicants request the withdrawal of the requirement for restriction and the examination of all of the claims of Groups I-IX at the same time.

Conclusion

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,


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